

RK

The opinion in support of the decision being entered
today was not written for publication and is not
binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BINH NGUYEN and SANDEEP SINGHAL

Appeal No. 2004-1627
Application No. 09/207,945

ON BRIEF



Before DIXON, LEVY and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-4, 6-13, 15-17, 19-23, 25-32, 34-36, 38-42, 44-51, 53-55 and 57, which are all of the claims pending in this application.

We reverse.

BACKGROUND

Appellants' invention is directed to a method and an apparatus for personalized content delivery to Web site visitors by dynamically generating Web page content with a user upon the request from a server by the user. An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

1. A method of associating dynamically generated Web page content with a user who requests a Web page from a Web server, wherein the user makes the Web page request via a Web client in communication with the Web server, the method comprising the following steps performed by the Web server:

storing a record of the user request within a Web server log;

generating the requested Web page, wherein the generated Web page includes a content object having a unique identifier associated therewith, wherein the unique identifier is generated via a hashing function;

serving the generated Web page to the Web client; and

appending the stored record of the user request with the unique identifier associated with the content object included within the generated Web page.

The Examiner relies on the following references:

Monier	5,974,455	Oct. 26, 1999
Wodarz et al. (Wodarz)	5,999,912	Dec. 7, 1999 (filed May 1, 1997)
Blumenau	6,108,637	Aug. 22, 2000 (filed Sep. 3, 1996)
Shaw et al. (Shaw)	6,311,211	Oct. 30, 2001 (filed Jan. 14, 1999)

Appeal No. 2004-1627
Application No. 09/207,945

Claims 1-4, 6-13, 15-17, 19-23, 25-32, 34-36, 38-42, 44-51, 53-55 and 57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wodarz, Monier, Blumenau and Shaw.

We make reference to the answer (Paper No. 35, mailed February 24, 2004) for the Examiner's reasoning, and to the appeal brief (Paper No. 34, filed December 11, 2003) and the reply brief (Paper No. 36, filed March 15, 2004) for Appellants' arguments thereagainst.

OPINION

In rejecting the claims, the Examiner, in addition to Wodarz and Monier relies on Blumenau for teaching the step of appending the stored record of the user request with a unique URL identifier and on Shaw for logging an advertisement ID in a log file for the server process (answer, page 5). Based on the teachings of these prior art references, the Examiner concludes that the skilled artisan would have found it obvious to store information about an object content in a log file since the advertisement "eligible to particular user" can be determined (id.).

Appellants point out that the combination of Blumenau and Shaw does not disclose or suggest the claimed step of "appending the stored record of the user request with the unique identifier associated with the content object included within the generated

Appeal No. 2004-1627
Application No. 09/207,945

Web page" (brief, page 4). Appellants specifically argue that what the examiner characterizes as "appending the stored record" in Blumenau is actually a series of separate entries in the log file for each one of the multiple transferred files resulted from a request for a web page (brief, page 5 & reply brief, page 3). Additionally, Appellants point out that Shaw merely discloses a server which uses information in a member profile and/or an event log file to determine which advertisements should be directed to a particular user (brief, page 6).

In response to Appellants' arguments, the Examiner asserts that storing the record of the requested files as a "log file" in Blumenau indicates that the stored log file is not different from the claimed "appending the stored record of the user request" (answer, page 16). The Examiner further argues that the fact that Blumenau generates the requested Web page "by analyzing transactions in the log file," proves that the identifications or the information of other files are stored in the log file (answer, page 17).

As a general proposition, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598

Appeal No. 2004-1627
Application No. 09/207,945

(Fed. Cir. 1988). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

After reviewing Blumenau, we agree with Appellants that storing the file information as "separate" transactions in the

log file, as disclosed by Blumenau, is different from the claimed appending the stored record. Blumenau generates a display of the Web page requested by a user while a record of the requests for files is stored on the server (col. 2, lines 29-35). However, this stored record of the requests, or the log file, refers to a number of transactions which individually include multiple fields for storing predefined type of information about the requested file (col. 2, lines 37-44). Therefore, what the Examiner characterizes as the claimed "appending the stored record" in Blumenau (answer, page 17), actually relates to storing additional or new transactions in the log file (col. 3, lines 1-3) which presents no useful correspondence between the number of transactions in a log file and the number of times an advertisement has been visited on a Web page (col. 3, lines 4-15). This problem is what Blumenau solves by identifying and eliminating the "redundant" transactions from the log file in order to obtain a more accurate "hit count" (col. 3, lines 16-25). Therefore, as pointed out by Appellants (reply brief, page 3), although Blumenau includes items or fields in the log file for each transferred file, additional information are added to the log file as new transaction records instead of appending a stored record.

Shaw, on the other hand, provides advocacy messages or advertisements to users based on the information stored in a member profile (col. 4, lines 39-45). Although the Examiner relies on the fact that Shaw assigns an identifier to the advertisement log (col. 11, lines 56-57), we remain unconvinced that Shaw can teach or suggest the claimed "appending the stored record." In fact, in concluding that adding more transactions to the log file of Blumenau and logging an advertisement ID in the server of Shaw provide the necessary teaching and suggestion for arriving at the claimed subject matter in claim 1, the Examiner attempts to forge a combination of an evaluation system by eliminating redundant hit counts that has nothing to do with a system for distributing specific advertisements to each user.

Thus, assuming, arguendo, that it would have been obvious to combine Wodarz, Monier and Blumenau with Shaw, as held by the Examiner, the combination would still fall short of teaching or suggesting the claimed "appending the stored record of the user request." We note that all the other independent claims, similar to claim 1, require "appending the stored record of the user request," in addition to other features. Accordingly, as the Examiner has failed to set forth a prima facie case of obviousness, we cannot sustain the 35 U.S.C. § 103 rejection of claims 1-4, 6-13, 15-17, 19-23, 25-32, 34-36, 38-42, 44-51, 53-55 and 57 over Wodarz, Monier, Blumenau and Shaw.

Appeal No. 2004-1627
Application No. 09/207,945

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-4, 6-13, 15-17, 19-23, 25-32, 34-36, 38-42, 44-51, 53-55 and 57 under 35 U.S.C. § 103 is reversed.

REVERSED

MDS/RWK

Appeal No. 2004-1627
Application No. 09/207,945

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627